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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/609,904	07/03/2000	Kenneth-Kang Yeh	WNS.P0001	3267

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Kenneth-Kang Yeh
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EXAMINER

NG, CHRISTINE Y

ART UNIT	PAPER NUMBER
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2663

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DATE MAILED: 12/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

TS

Office Action Summary

Application No.

09/609,904

Applicant(s)

YEH, KENNETH-KANG

Examiner

Christine Ng

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 July 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 July 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 9 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 9, the text is confusing because it claims "the call is automatically placed by the second communication device", but claim 1 claims in lines 4-6 that the first communication device places a call to the second communication device. It is unclear whether the first or second communication device places the call.

In claim 21, the text is confusing because it claims "the call is automatically placed by the second communication device", but claim 13 claims in lines 4-6 that the first communication device places a call to the second communication device. It is unclear whether the first or second communication device places the call.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3, 5-10, 13-15, 17-22 and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,192,044 to Mack.

Referring to claims 1 and 13, Mack discloses in Figure 1 a method comprising receiving an unique string identifier from a first communication device (Caller PC, Element 14). The method also comprises responding to the first communication device (Caller PC, Element 14) with a telephone number that enables the first communication device (Caller PC, Element 14) to place a call to a second communication device (Callee PC, Element 18) represented by the unique string identifier. The caller PC (Element 14) sends the user identifier of a callee PC (Element 18) to a Lookup server (Figure 4, Element 194), which then returns to the caller PC (Element 14) the telephone number of the callee PC (Element 18) in order for the caller PC (Element 14) to call the callee PC (Element 18). Refer to Column 5, line 62 to Column 6, line 9. Mack does not disclose that the user identifier is an email address. However, Mack discloses that "a user identifier can include a person's name, postal address, electronic mail address, social security number, and other commonly used identifiers" (Column 6, lines 35-46). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include that the user identifier is an e-mail address; the motivation being that an e-mail address is a commonly used identifier.

Referring to claims 2 and 14, Mack discloses in Figure 1 that the first communication device (Caller PC, Element 14) is a device utilizing Internet Protocol based telephony. Refer to Column 2, lines 46-56.

Referring to claims 3 and 15, Mack discloses in Figure 1 that the second communication device (Callee PC, Element 18) is POTS based telephony device. Refer to Column 2, lines 57-64.

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Referring to claims 5 and 17, Mack discloses in Figure 4 that a Wireless Name Service Server (Lookup server, Element 194) is receiving the unique string identifier. The lookup server (Element 194) receives a unique string identifier from a caller PC (Figure 1, Element 14). Refer to Column 6, lines 35-46.

Referring to claims 6 and 18, Mack discloses in Figure 1 that the method further comprises inputting the unique string identifier on the first communication device (Caller PC, Element 14). Refer to Column 6, lines 37-42. The method also comprises transmitting the unique string identifier to the wireless name service server (Figure 4; Lookup server, Element 194). Refer to Column 6, lines 42-46.

Referring to claims 7 and 19, Mack discloses in Figure 4 that the method further comprises looking up on the server (Lookup server, Element 194) the telephone number using the received unique string identifier as a key thereto. The lookup server (Element 194) "queries an association table with the user identifier for a user network access provider machine address and also the user telephone number" (Column 6, lines 42-46).

Referring to claims 8 and 20, Mack discloses in Figure 4 that the method further comprises that responding is performed by the wireless name service server Lookup server, Element 194). The lookup server (Element 194) sends to the Caller PC (Element 14) the telephone number of the Callee PC (Element 18). Refer to Column 6, lines 44-45.

Referring to claims 9 and 21, Mack discloses that the call is automatically by the second communication device (Callee PC, Element 18). The Caller PC (Element 14)

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calls the Callee PC (Element 18) to establish a PSTN connection through a callee connection service (Figure 4, Element 128). Refer to Column 6, lines 4-9.

Referring to claims 10 and 22, Mack discloses in Figure 1 that the call automatically placed on behalf of the second communication device (Callee PC, Element 18). The Caller PC (Element 14) calls the Callee PC (Element 18) to establish a PSTN connection through a callee connection service (Figure 4, Element 128). Refer to Column 6, lines 4-9.

Referring to claim 25, Mack discloses in Figures 1 and 4 a system (Figure 4) comprises a server (Figure 4; White Pages Service, Element 190) with a means for receiving an user identifier from a first communication device (Figure 1; Caller PC, Element 14). The server also comprises the means (Figure 4; Lookup Server, Element 194) for responding to the first communication device (Figure 1; Caller PC, Element 14) with a telephone number, which enables the first communication device (Figure 1; Caller PC, Element 14) to place a call to a second communication device (Figure 1; Callee PC, Element 18) represented by the user identifier. Refer to Column 4, lines 21-27 and Column 5, line 62 to Column 6, line 9. Mack does not disclose that the user identifier is an email address. However, Mack discloses that "a user identifier can include a person's name, postal address, electronic mail address, social security number, and other commonly used identifiers" (Column 6, lines 35-46). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include that the user identifier is an e-mail address; the motivation being that an e-mail address is a commonly used identifier.

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Referring to claim 26, Mack discloses in Figure 1 that the first communication device (Caller PC, Element 14) includes means for inputting the user identifier. Refer to Column 6, lines 37-42.

Referring to claim 27, Mack discloses in Figure 4 that the system includes a means (Callee connection service; Element 128) for automatically placing a call to the second communication device using the telephone number. The Caller PC (Figure 1, Element 14) calls the Callee PC (Figure 1, Element 18) to establish a PSTN connection through the callee connection service (Figure 4, Element 128). Refer to Column 6, lines 4-9.

5. Claim 4 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,192,044 to Mack in view of U.S. Publication No. 20020058499 to Ortiz. Mack does not disclose that the wireless telephony device is a cellular telephone. Ortiz disclose that wireless telephony devices can be cellular phones, which are part of wireless networks that are "continuing to be expanded and integrated with new applications and services that are compatible with the growing number of wireless devices", such as PDA's (Paragraph 0005, lines 12-15). In addition, cellular telephones are becoming "web-enabled" (Paragraph 0005, line 8). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include that the wireless telephony device is a cellular telephone; the motivation being that cellular telephones are becoming "web-enabled" and can be integrated with new wireless devices such as PDA's. Furthermore, cellular telephones offer mobile convenience when one does not have access to a conventional telephone.

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6. Claim 11 and 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,192,044 to Mack in view of U.S. Patent No. 5,805,587 to Norris et al. Mack does not disclose that the telephone number is displayed on the second communication device. Norris et al disclose that the telephone number of the calling party is displayed on a computer (Figure 1, Element DT1). When the computer receives a telephone call, the calling number and call answer options are displayed on the screen. Call answer options include connecting to voice mail, terminating the call or connecting the call via the Internet. Refer to Column 2, lines 7-15 and Column 8, lines 20-48. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include that the telephone number is displayed on the second communication device; the motivation being that the called party can decide how to handle the call (terminate the call, transfer to voice mail or connect the call via the Internet) based on who is calling by looking at the telephone number.

7. Claims 12, 24 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,192,044 to Mack in view of U.S. Patent No. 6,546,005 to Berkley et al. Mack does not disclose responding to the first communication device with information other than the telephone number, the other information including proper names, addresses, preferences and data relating to the owner of the second communication device represented by the unique string identifier. Berkley et al disclose in Figure 2 an Active User Register (AUR) consisting of a series of user records relating to the owner of the second communication device (user device) represented by a unique string identifier (user name, Element 210). Other than the telephone number

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(Element 220), entries of each user record include proper names (aliases, Element 210), addresses (voicemail and email, Elements 230 and 240), preferences (preferences to be contacted according to time of day or day of week to preferences based upon the identity of the subscriber who is attempting to communicating with the user), and data (textual documents such as resumes, Element 280). Refer to Column 7, line 38 to Column 8, line 42 and Column 9, lines 11-22. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include responding to the first communication device with information including proper names, addresses, preferences and data relating to the owner of the second communication device in order to "broker between a subscriber's request for communications contact information corresponding to a user and the user's preferences of being reached by various communications alternatives" (Column 4, lines 51-56). By establishing preferences, the user can determine where calls are to be routed (voicemail, telephone, computer, etc) depending on the time of day, day of week and identity of the caller.


Conclusion


8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christine Ng whose telephone number is (703) 305-8395. The examiner can normally be reached on M-F; 8:00 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nguyen Chau can be reached on (703) 308-5340. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9314.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-8395.

C. Ng 
November 20, 2003



CHAU NGUYEN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600